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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,641	09/26/2003	Robert J. Drost	SUN-P9609	7883

57960 7590 08/02/2006

SUN MICROSYSTEMS INC.
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DAVIS, CA 95618-7759

EXAMINER

WELLS, KENNETH B

ART UNIT	PAPER NUMBER
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2816

DATE MAILED: 08/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671,641

Applicant(s)

DROST ET AL.

Examiner

Kenneth B. Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11-17 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 11-17 and 19-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The RCE filed on 6/8/06 and 1.116 amendments filed on 5/15/06 have now been entered in the case.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 3, 4, 6-9, 11, 12, 14-17, 19, 20 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al in view of any one of Self et al '308, Self et al '532, Bar-Niv, Oman et al, and Eggebrecht et al, and further in view of any one of Lenk, Chesavage '626, Locker et al, Doblar et al, Smith et al, Yabuki et al and Chesavage '350.

See paragraph three of the previous office action for the details of this rejection. As to the new limitations added to the claims, such recitations cannot be relied upon to distinguish over the above-noted combination of prior art because such is merely "result" language (or, alternatively will be inherent function). For example, applicant now recites that the slower chip "can recognize" and "respond appropriately" to the faster chip. This is not a positive limitation of the present invention, and therefore should not be included in the claims at all. Rather, as applicant is well aware, for claims to distinguish over prior art, it is necessary to have some

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structural difference over the prior art (in this case a combination of prior art references). Here, however, applicant has not pointed out (or claimed) any structural difference between the invention and the above-noted combination of prior art. Instead, applicant has recited what occurs during operation of his circuitry and/or what potential benefits will result during such operation. As noted above, the recited operation will be inherent (because the structural features of applicant's invention are all met under 35 U.S.C. 103) and the potential benefits will be the same as well. However, as noted above, such potential benefits should not even be set forth in the claims at all.

4. Claims 5, 13 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al in view of any one of Self et al '308, Self et al '532, Bar-Niv, Oman et al, and Eggebrecht et al, and further in view of any one of Lenk, Chesavage '626, Locker et al, Doblar et al, Smith et al, Yabuki et al and Chesavage '350 as applied to claims 1, 3, 4, 6-9, 11, 12, 14-17, 19, 20 and 22-27 above, and further in view of Coleman.

See paragraph four of the previous office action for the details of this rejection.

5. Applicant's arguments filed on 5/15/06 have been fully considered but they are not persuasive.

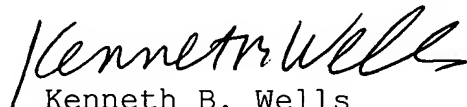
As noted above, the new limitations added to the claims cannot be relied upon to distinguish over the above-noted combination of prior art because such language is merely "result" (or, alternatively will be inherent function). For example, applicant now recites that the slower chip "can recognize" and "respond appropriately" to the faster chip. This is not a positive limitation of the present invention, and therefore should not be included in the claims at all. Rather, as applicant is well aware, for claims to distinguish over prior art, it is necessary to have some structural difference over the prior art (in this case a combination of prior art references). Here, however, applicant has not pointed out (or claimed) any structural difference between the invention and the above-noted combination of prior art. Instead, applicant has recited what occurs during operation of his circuitry and/or what potential benefits will result during such operation. As noted above, the recited operation will be inherent (because the structural features of applicant's invention are all met under 35 U.S.C. 103) and the potential benefits will be the same as well. However, as noted above, such potential benefits should not even be set forth in the claims at all.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth B. Wells whose telephone number is (571)272-1757. The examiner can normally be reached on Monday through Friday from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy P. Callahan, can be reached at (571)272-1740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kenneth B. Wells
Primary Examiner
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July 21, 2006